

REMARKS

Claims 1-20 are pending in this application.

I. Withdrawal of Objections and Rejections

The Applicant appreciates the withdrawal of the drawing objections, claim objections and the 35USC§112 rejections.

The Examiner suggested that claim 18 also include “further comprised”. However, claim 18, unlike claim 20 is not referring to the previous step, but introduces the step of selecting an advance-transmitting function. Therefore, “comprising” is appropriate.

II. Claim Rejections - 35 USC § 102

A. Claims 1 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida et al. U.S. Patent No. 6,449,063 (hereinafter Yoshida). The Applicant respectfully traverses.

1. With respect to claim 1, in paper no. 20050831, the Examiner stated that Yoshida teaches requiring and receiving said data output order by said facsimile transmitting part from said facsimile receiving part after the telephone number of said facsimile receiving part is dialed (S88).

However, the data output order is not taught or suggested to be sent from the transmitting part to the receiving part after dialing because Yoshida’s order is the same whether there is a single side

printing or double sided printing. Its only when there is an error in the printing that a blank page is avoided on a side. The order itself is not changed, but rather when there is an error, the back side is not printed on. As mentioned on col. 10, lines 54-57, always retransmitting from the front side at the same time of transmission of the both side document sheet as an error re-transmission. Yoshida helps in retransmitting of a transmission with an error without concern for the collation of the print.

Therefore, the both side and single sided printing is not actually a setting of the printing order itself as mentioned in col. 10, lines 41-45, when there is a both side print, it is sequentially transmitted and the one side document would be printed the same way, but not printed on the back side. The actual printing order is not affected, rather in retransmission Yoshida does not force the reverse side to be printed on the front side. The reverse page is kept on the reverse page in the retransmission while the front page is kept on the retransmission. The present invention, however concerns the actual output order which is sent by the receiving part and received by the transmitting part after dialing.

In Yoshida, the output order remains the same which is still sequential.

2. In addition, the present invention states that the stored document is transmitted according to the received data output order. The data that is transmitted by Yoshida is not varied according to the order received, but when retransmitting, the front side is sent. The order of the output is never actually sent, but rather the output is varied when there is an error and a retransmission.

The Examiner assumed that the order is sent as the Examiner assumes no sorting, but no such

teaching is actually made that no sorting is necessary. Rather the background and summary deals with after an error the print is not improperly started on a different side. Therefore, actual collation of the print may still be necessary if printed different than the receiving part receives the paper as such is not taken into account by Yoshida.

3. Yoshida actually does not disclose that controlling a transmission of fax data according to a data output order of a facsimile part because, when re-transmitting, the retransmission always has the front side sent first according to col. 10 of Yoshida. Therefore, the order itself is not varied or affected.

4. With respect to claim 6, the Examiner states that Yoshida teaches said requiring of said document order being made during Phase B of a facsimile transmission.

However, the presence absence of both side reception is not the output order. According to MPEP §2131, the elements must be literally present and exactly as arranged in the claim. The presence or absence of both side reception does not deal with the order, rather it deals with the side of the paper. The printing is still done in Yoshida in the same sequential order. The actual order is not changed, but only that a retransmission resets the front page first printing.

5. With respect to claim 7, the Examiner stated that Yoshida teaches the method of claim 1, with said dialing a predetermined telephone number of said facsimile receiving part being automatic (S84 in fig. 5).

The Examiner stated in paper no. 20050831 that the CKT 26 dials the destination number automatically when receiving a *call command pulse*. However, col. 3, lines 22-25 states that it is a select signal of DTMF which is sent after a call command pulse. Therefore, this is not automatic but actually manual. Select signal can still be manually given and therefore, there is no exact teaching that it is actually automatic.

The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). Here, is clear by using a circuit alone does not necessarily mean automatic.

III. Claim Rejections - 35 USC § 103

1. With respect to claim 2, the Examiner argues that single sided printing and dual sided printing is the order of the print that is displayed. However, as mentioned above, dual sided printing and single sided printing is still printing in the same order and not different, rather its on what side of the page is actually used. Therefore, claim 2 is not obvious.

2. With respect to claims 4 and 11, the Examiner provides a different suggestion/motivation to combine in paper number 20050831. As mentioned in MPEP §706.07, “ Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public...present practice does not sanction hasty and ill-considered final rejections.

The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application....The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.”

Therefore, the finality should be removed.

Moreover, the suggestion an motivation given by the examiner is still not clear and particular.

3. With respect to claim 18, the Examiner stated that Ishizuka, teaches the advance transmitting function by the inquiry key 220 that is selected. However the key is inquiring whether there is dual sided printing or dual sided reading. This again does not necessarily affect the order of the output.

Moreover, such an accommodation is not made when the call is connected as no such teaching on col. 7 of Ishizuka is made.

4. With respect to claims 19 and 20, the Examiner stated that by indicating the capability of dual side or single sided printing capability, it then shows the order it prints. However, again, the

actual order of printing would be still in the same sequential order, thereby the order itself is never displayed.

Moreover, identifying does not necessarily mean displaying. One can identify without displaying for a user to see. The identification mentioned is more of a determination rather than an actual display.

Respectfully, the Examiner is improperly stretching the teaching of the references to accommodate a rejection.

5. Concerning claim 19 and 20, the sequence in which the output order is displayed and the data is transmitted is not taught or suggested. In claim 19, the output order is displayed and then after it is displayed, then the data is transmitted. In claim 20, the displaying of the output order is when the output order is received. However, in Ishizuka, there is only a mention that when there is an identification of the dual side “reading” function and dual side recording function, that there is an instruction made.

B. Claims 13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Ishizuka and in further in view of Bloomfield U.S. Patent No. 6,693,729. The Applicant respectfully traverses.

1. With respect to claim 13, the above arguments apply. Further, the Examiner clarifies the motivation to combine. However, with the clarification, the Examiner should then remove the finality of the rejection as mentioned above according to MPEP §706.07 to give the Applicant a proper avenue to respond to the Examiner's rejection.

C. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida, Ishizuka and Bloomfield as applied to claim 13 above and in further view of Suzuki. The Applicant respectfully traverses.

The Examiner had failed any motivation to combine all the above mentioned references originally. Only in the advisory action of paper number 20050831 does the Examiner even give a motivation to combine. Therefore, as mentioned above, according to MPEP §706.07, the finality of the rejection must be removed.

IV. Withdrawal of Finality

The Examiner is asked again to remove the finality of the rejection based on the changing of the motivation to combine and addition of the motivation to combine when none was ever given in the final rejection as seen in claims 4, 11, 13 and 14.

In addition, the Examiner stated that the new grounds for rejection are necessitated by the amendments by the Applicant. However, this is not correct. As seen in claim 1 for example, the amendment was only done for clarification reasons of lending consistency in the use of facsimile as it seen in line 3. However, this should not afford a whole new rejection and new references applied. The same is true for the amendments of claims 1, 2, 4-8, 11, 13, 15 and 17.

The *Manual of Patent Examining Procedure* (MPEP) states “Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art” (MPEP § 706.07(a)).

Therefore, the MPEP § 706.07(a) indicates that a second action on the merits *will not be made final* if it includes a rejection, on newly cited art, of any claim not amended by applicant in spite of the fact that other claims may have been amended to require newly cited art.

Furthermore, the definition of “a new ground for rejection” does not only refer to newly cited references, but to the below mentioned new grounds for rejection as MPEP 706.07(a) specifically mentions the case of newly cited references separately from “a new ground for rejection” afterwards as “Furthermore, a second or any subsequent action on the merits in any application or patent

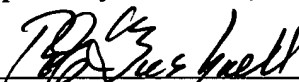
undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.”

For all of the foregoing reasons, the Applicant respectfully believes that the Paper No. 20050505 is a premature final Office action because of the new grounds for rejection of claims 1-20 were not necessitated by amendment nor based on information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p). In addition, the Examiner had to modify or add motivation to combine where no motivation was given or not given properly in claims 4, 11, 13 and 14.

In view of the foregoing remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

A fee of \$450.00 is incurred by this Response for two (2) month extension of time. Applicant's check drawn to the order of the Commissioner accompanies this Response. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



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